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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,695	11/04/2003	Yoichiro Yamashita	1131-0491P	5835

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EXAMINER

MAYES, DIONNE WALLS

ART UNIT PAPER NUMBER

1731

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/699,695

Applicant(s)

YAMASHITA ET AL.

Examiner

Dionne Walls Mayes

Art Unit

1731

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8,11-13 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 11-13, 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Reopening of Prosecution/Withdrawal of Previously-Indicated Allowable Subject Matter

1. After reconsidering the prior art of record, namely the Kaneki et al reference, the Examiner has determined that a new ground of rejection should be made over the claims as filed on March 20, 2006. Therefore, the FINALITY of the rejection of the last Office Action, dated December 21, 2005, and the indication of allowable subject matter has been WITHDRAWN. In view of the discovery of the above-cited art, PROSECUTION IS HEREBY REOPENED as set forth below.

Claim Objections

2. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, namely claim 1 which already includes a limitation of a filter element including particles of adsorbent distributed through the filter material. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner believes that the addition of the word "like" to an otherwise definite expression extends the scope of the expression so as to render it indefinite. It is suggested that Applicant delete the word "rod-like" from this claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 6-8, 11-13, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneki et al (US. Pat. No. 6,568,402) in view of Aronoff et al (US. Pat. No. 5,107,866).

Kaneki et al discloses nearly all that is recited in the claim since it teaches a filter assembly having two cylindrical filter elements arranged, in tandem, each of said elements including a filter material, 41, 42 – filter 41 being a plain filter, and filter 42 being a plain filter having activated carbon particles added thereto (corresponding to the claimed "charcoal filter"); wrapping material wound around each filter material element, 43, 44 (corresponding to the claimed "wrapping paper"); and wrapper paper, 12 (corresponding to the claimed "forming paper"), wound around the wrapping materials of the two filter elements to connect the two to each other. While there may be no specific discussion of adhesive provided between the wrapping material and the filter, and between the wrapping material and wrapping paper, it follows that one would have applied said adhesive in such manner as to secure the wrapping to the filter elements in

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order to secure the elements together, as such is well-known – as evidenced by the Aronoff et al reference – which discloses that the adhesive material can be applied in a spiral manner (corresponding to the claimed “loop pattern”) – if desired, or in a banded pattern, see Fig. 3 (corresponding to the claimed “plurality of adhesive-applied parts arranged at intervals in an axial direction of the filter element”). Further, it would have been obvious to one having ordinary skill in the art at the time of the invention to have also applied the same adhesive between the two wrapping materials in order to further secure same to ensure the filter elements will be sufficiently positioned during smoking.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dionne Walls Mayes
Primary Examiner
Art Unit 1731

April 3, 2006